

REMARKS

This is in reply to the office dated 12 March 2008. The office action set a restriction requirement. Election with arguments for traversal are provided below. Amendments are provided to place the claims in better U.S. form while maintaining the scope and thus the grouping of the claims as set forth in the office action for purposes of restriction. Claims 1-17 have been canceled, and new claims 18-39 have been added. Claims 18-39 will therefore be pending upon entry of the above amendments.

Specification.

The paragraph beginning on page 4, line 32 was amended to change the word “freak” to -abnormal-- , a better English translation.

The paragraph beginning on page 10, line 8 of the specification has been amended herein. This paragraph was originally amended in the Request for Early Processing and Preliminary Amendment filed on January 17, 2006 (“the January 17 amendment”). The location of the amended paragraph was erroneously identified in the January 17 amendment. The amended version of the paragraph presented herein therefore includes the amendment originally presented in the January 17 amendment (deletion of the words “horizontally [sic]”).

The amended paragraph presented herein also includes the following amendment presented for the first time: replacement of the phrase “with respect to the” with --for the purpose of achieving a--. This amendment clarifies an apparent translation-related discrepancy, and is consistent with the depiction of the restrictor pipe (7) and the gob outlet (5, 5') in Figure 2 of the as-filed application. In addition, the word “know” has been replaced with “known” to correct an apparent typographical error.

Claims.

The preamble of the new claims replaces the term “controlling” as set forth in the English translation of the application as filed with the term “regulating. This is believed to be a more accurate translation of the German term “regelung” as used in the original PCT application.

The new claims are similar in scope to the claims canceled, and place the claims in better U.S. form. The present claims are fully supported by the previous claims and thus no new matter has been added.

In the office action of March 12, 2008, for purposes of restriction, the claims were placed into two groups, Group I drawn to a method of controlling the glass gob mass in the production of hollow glass containers, and Group II drawn to a device for controlling the glass gob mass. In keeping with this grouping, the new claims, analogous to the canceled claims, are classified as follows:

Group I: claims 18 to 27 and 38 to 39 (method);

Group II: claims 28 to 37 (device).

Restriction.

The office action of March 12, 2008 sets an office action on the basis that the two groups of inventions are not linked so as to form a single general inventive concept under PCT rule 13.1. The action thus requires an election of a single invention. Applicant hereby provisionally elects the invention of Group II (the device claims) which include claims 28 to 37. This election is made with traverse. Applicants arguments in support of this traversal are set forth below.

Applicant concurs with the determination made at the international level that there is in fact unity of invention among the claimed inventions, and requests that this determination be followed. It is believed that the examiner erred in the present restriction requirement by listing incomplete common technical features of the alleged invention groups I and II and not using the common technical feature indicated by the International Preliminary Report on Patentability. Filed herewith are the following documents related to the present application (from the PCT stage):

1. Notification of Transmittal of Copies of Translation of the International Preliminary Report on Patentability mailed 9 November 2006;
2. International Preliminary Report on Patentability in English; and
3. the English translation of the Written Opinion of the International Searching Authority.

Although the U.S. designate/elected office has waived the requirement of transmittal of these documents, the U.S. PTO can receive them upon request. It is further noted that Box No. VIII of the International Preliminary Report on Patentability in English (number 2 above) indicates that applicant provided observations to the written opinion, which document was titled “Informative Written Reply to the Written Opinion of the International Searching Authority filed with the PCT office on December 30, 2005, a copy of which was filed with the U.S. PTO on January 17, 2006 upon entry into the national phase.

It is noted that both items 2 and 3 above indicate that there is in fact unity of invention among the original claims as both items have left Box No. IV unchecked for lack of unity convention. Moreover, the Written Opinion specifically discusses the technical feature in both claims 1 and 11 that is both novel and inventive. As discussed below, this same common technical feature remains in the present analogous claim set.

The standard for determining Unity of Invention is set forth in the PCT International Search and Preliminary Examination Guidelines, Part III, Chapter 10 (copy provided herewith) and which is referred to in MPEP §1850 as providing specific examples of the application of the Unity of Invention; see also Annex B of the Administrative Instructions Under the PCT (a copy can be found in the MPEP).

Unity of invention exists when there is a technical relationship among the claimed inventions involving one or more of the same for corresponding special technical features. The “special technical features” is defined in PCT rule 13.2 as meaning those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art. Furthermore, unity of invention is considered in relation to the independent claims. In the present application, there are at least two common special technical features that lead to unity of invention. None of these special technical features were cited in the present office action even though at least one of them was cited in the Written Opinion of the International Searching Authority (item no. 3 above). These common technical features remain in the present claims.

One technical feature is that the mass reference value difference for a glass gob (after it is created) is determined and used to change the plunger movement profile used for a subsequent gob (the plunger movement profile influences the mass of the gob created) so that the mass of

the subsequent gob moves closer to the mass reference desired value. By subsequent repetition of this, i.e., determination of the past reference value difference of a gob with subsequent change to the movement profile for creating a gob, the mass reference actual value of subsequent gobs can change in a stepwise manner to approximate the mass reference desired value. The adjustment is stepwise in that the adjustment of the movement profile can be made for each subsequent gob until the approximate desired value is reached. This technical feature was noted in the English translation of the Written Opinion of the International Searching Authority and also noted as a reason for novelty and inventive step of both claim 1 (method claim) and 11 (device claim) of the prior claims. This same special technical feature supports unity of invention with the present claims.

With reference to method claims 18 and 38, and device claim 28, it is seen that the same special technical feature as discussed above, and as noted in the English translation of the Written Opinion of the International Searching Authority, is present. Moreover, this feature was noted as novel and inventive in the Written Opinion. Accordingly, unity of invention is believed present for all of the claims.

Furthermore, the feature that “a mass reference value difference is determined” by itself is believed to constitute a special technical feature supporting unity of invention. This feature is present in independent claims 18, 28 and 38. This is another common technical feature supporting unity of invention.

It is further noted that a combination of inventions that include a process and apparatus specifically designed for carrying out the said process falls within the categories of inventions considered to have unity of invention. See 37 C.F.R. §1.475 and PCT International Search and Preliminary Examination Guidelines, Part III, Chapter 10, 10.22, Example 2.

The common technical features noted in the office action of March 12, 2008 are believed to be incorrect and or incomplete. These are as follows:

1. A glass forming machine (IS machine) with at least one plunger with a feeder head with means moving a plunger upwards and downwards,

2. With plunger movement having a control unit connected via data line for determining a mass reference value difference to form an assortment of hollow glass containers of different size (i.e. plungers having a defined distance and defined time to form said hollow glass containers) for each preform station of each section/glass forming machine.

This is inconsistent with the findings as set forth in the English translation of the Written Opinion of the International Searching Authority, and accordingly is believed to be incorrect as it ignores what is believed to be the “special technical features”.

Although 37 C.F.R §1.499 permits a restriction requirement to be made in a national phase application where unity of invention is lacking, no reasoning has been provided for overturning the finding of unity of invention at the International level based on the special technical features noted in the International Preliminary Report on Patentability and English translation of the Written Opinion of the International Searching Authority. Accordingly, for the reasons set forth above, it is respectfully requested that the restriction requirement be withdrawn and that all claims be examined.

Conclusion

A timely notice of allowance is respectfully requested.

Respectfully submitted,
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